

## **REMARKS**

Claims 29-56 were examined.

Claim 42 was objected to for an “obvious” dependency error which the Examiner noted (and which is now moot).

Claims 29, 31, 33, 34, 35, 37, 39, 44, 45, 51 were rejected.

Claims 30, 36, 38, 40-43, 46-50, and 52-56 were objected to as being dependent from a rejected base claim but were said to be allowable if rewritten in independent form that included all of the limitations of the base claim and any intervening claims.

Applicants have amended claims 29, 34, 39 by replacing “eukaryotic cell” with “yeast cell.” Accordingly, dependent claims 30, 41 and 52 have been canceled as superfluous because their subject matter is now incorporated in the above three base claims. This necessitated amendment of the dependencies of claims 42, 43, 53 and 56.

Claims 44, 45 and 54, reciting filamentous fungi or species thereof, have been canceled.

*(Applicants note that claim 54 was not listed among the rejected claims even though it was drawn to filamentous fungi, but believe this may have been the result of a clerical error on the part of the Office.)*

Therefore claims 29, 31-40, 42, 43, 46-51, 53, 55 and 56 remain in this case. No new matter has been added with the present amendments. The claims are now in condition for allowance, which is earnestly solicited.

### **I. Withdrawal of Prior § 112 Rejections**

Applicants thank the Examiner for withdrawing all the prior rejections based on failure to comply with the **written description** requirement and the **enablement** requirement in view of Applicants’ arguments and claim amendments.

### **II. Rejection Under 35 U.S.C. 103(a) (Obviousness)**

Claims 29, 31, 33, 34, 35, 37, 39, 44, 45, 51 were rejected as being obvious over Guan *et al.* (U.S. Patent 5,643,758) in view of Karlsson *et al.* (*Eur J Biochem*, 2001, 268:6498-507) and Accession Q9P8C9 (published 2000-10-01) for reasons cited in previous Actions. The present rejections were based on the fact that the independent claims (and the rejected dependent claims) all read on “eukaryotic” cells.

The Action notes, and the Examiner confirmed in follow-up telephone calls, that Applicants’ arguments as supported by the Van Dijken Rule 132 Declaration were persuasive to overcome any obviousness rejection of claims that recited **yeast** cells transformed with the

recited nucleic acids and the obviousness of claims directed to processes for producing ethanol and non-ethanolic fermentation products using the recited yeast cells.

### **III. Applicants' Response to § 103 Rejection**

While Applicants continue to disagree with this ground for rejection, to advance prosecution they have amended or canceled various claims as discussed above so that all the present claims are limited to "yeast" cells, and are therefore allowable. These amendments and cancellations are without prejudice to Applicants' presenting the broader claims in one or more continuation applications.

### **IV. Conclusion**

In view of the prior indication of allowable claims, the present amendments and the foregoing remarks, Applicants believe that they have overcome the pending grounds for rejection under § 103(a). Reconsideration, withdrawal of all the remaining rejections and allowance of all present claims 29, 31-40, 42, 43, 46-51, 53, 55 and 56 are respectfully requested.

**The Examiner is respectfully requested to contact the undersigned at (202) 628-5197 if any clarification is required or if further discussion will assist in advancing this case to issue.**

Respectfully submitted,  
Browdy and Neimark PLLC  
Attorneys for Applicants

By /Shmuel Livnat/  
Shmuel Livnat  
Registration No.: 33,949

624 Ninth Street, N.W.  
Washington, DC 20001  
Tel: (202) 628-5197  
Fax: (202) 737-3528